

## REMARKS

In Paragraphs 1 and 2 of the pending Office Action, the Examiner set forth an election/restriction requirement. The Office Action restricts pending claims 1-45 as follows:

Group I is drawn to a flexible coating, classified in class 424, subclass 422, currently embodied in claims 1-28;

Group II is drawn to a method for producing a coating, classified in class 424, subclass 400, currently embodied in claims 29-43;

Group III is drawn to a method for controlling the release rate, classified in class 424, subclass 424, currently embodied in claim 44; and

Group IV is drawn to a method of producing a coating, classified in class 424, subclass 400, currently embodied in claim 45.

### **I. Restriction.**

Applicants provisionally elect, with traverse, Group I. According to Section 803 of the M.P.E.P., restriction may properly be required between patentably distinct inventions if (1) the inventions are independent or distinct as claimed; and (2) there is a serious burden on the Examiner if restriction is not required. In this case, the entire patent system would be unnecessarily burdened with the additional application required and the duplicative work this restriction demand entails.

Specifically, Applicants respectfully submit that there will not be a serious burden on the Examiner if restriction between the claims is not required because regardless of the claims prosecuted, the field of search for each of the identified species will substantially overlap, if not be identical to the other. A separate field of search is shown to exist only when one of the distinct subjects can be searched in places where no pertinent art to the other subject exists. In this case, however, there is no indication that a separate field of search is required for the distinct

inventions as all of the groupings suggested by the Examiner are within class 424. Thus, Applicants respectfully contend that there will not be a serious burden on the Examiner if restriction is not required.

Furthermore, it is well established that restriction is not mandatory merely because the subject matter of the claims may be separately classified. In the present application, since the claims are so closely related, the fields of search would necessarily be co-extensive. The fact that the composition and methods related to that composition may have acquired a separate status in the art, as stated by the Examiner, is not seen to be a material factor, at least insofar as the restriction requirement for the present invention is concerned.

Applicants additionally respectfully submit that the restriction requirement is improper under 37 C.F.R. 1.141 and M.P.E.P. § 806.05(i). 37 C.F.R. 1.141(b) which reads as follows:

(b) Where claims to all three categories, product, process of making, and process of use, are included in a national application, a three way requirement can only be made where the process of making is distinct from the product. If the process of making and the product are not distinct, the process of using may be joined with the claims directed to the product and the process of making the product even though a showing of distinctness between the product and the process can be made.

Further, M.P.E.P. § 806.05 (i) states the following:

Where the product claims are allowable (i.e., novel and nonobvious), restriction may be required only where the process of making and the product made are distinct (M.P.E.P. § 806.05(f); otherwise, *the process of using must be joined with the process of making and the product made*, even if a showing of distinctness can be made between the product and the process of using (M.P.E.P. §806.05(h)) (emphasis added).

Applicants submit that the product claims (1-28) are novel and nonobvious and thus allowable; further, there is no basis here for determining that the process of making claims (29-43 and 45), the process of controlling the release rate claim 44 and the product claims (1-28) are distinct inventions under M.P.E.P. § 806.05(f). Thus, the process of using must be joined with the process of making and the product made under M.P.E.P. § 806.05(i), rendering this restriction requirement improper. Additionally, claims 29-45 (Groups II, III, and IV) cannot be practiced without also practicing claims 1-28 (Group I). Again, restriction is improper; see

M.P.E.P. § 806.05(i). For these reasons, Applicants respectfully request that the Examiner reconsider and withdraw the restriction requirement.

Furthermore, contrary to the Examiner's assertion that the different inventions do not contain the same ingredients and are unrelated, the Applicants respectfully disagree. The methods related to the coating as contained within Group II, III and IV make use of the composition that is contained within Group I. Specifically, the method presented in Group III further emphasizes the use of adjusting the composition of the coating contained within Group I to achieve a desired release rate of the active components contained within the coating composition. In light of the above remarks, it is believed that an action on the merits of claims 1-45 in a single application is in order.

## **II. Election of Species.**

In paragraph 8, the Examiner further states that pending claims contains claims directed to the following patentably distinct species of the claimed invention:

### **Species in Group I**

- a) pharmacological compounds in claims 9, 23;
- b) pharmacological compounds in claims 10, 24; and
- c) pharmacological compounds in claims 11, 25.

### **Species in Group II**

- a) pharmacological compounds in claim 41;
- b) pharmacological compounds in claim 42; and
- c) pharmacological compounds in claim 43.

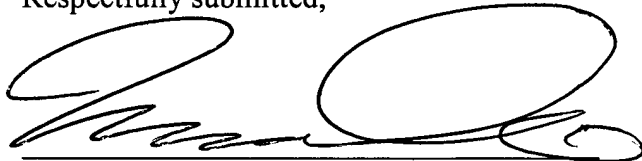
The Examiner is requesting that the Applicants elect a single species of the disclosed pharmacological compounds. Applicants respectfully traverse this election of species requirement, however, provisionally elect the following species disclosed in Group I as that species contained with the grouping (a) pharmacological compounds in claims 9 and 23 that consists of anti-microbials.

Specifically, Applicants respectfully submit that there will not be a serious burden on the Examiner if election of species is not required because regardless of the claims prosecuted, the field of search for each of the identified species will substantially overlap, if not be identical to the other. A separate field of search is shown to exist only when one of the distinct subjects can be searched in places where no pertinent art to the other subject exists. In this case, however, there is no indication that a separate field of search is required for each of the disclosed species as all the species identified consists of compound having anti-microbial action upon fungal and bacterial organisms. Thus, Applicants respectfully contend that there will not be a serious burden on the Examiner if restriction is not required and would therefore respectfully request that the species election be withdrawn.

#### CONCLUSION

The claims remaining within the application are believed to patentably distinguish over the prior art and to be in condition for allowance. Early and favorable consideration of this application is respectfully requested.

Respectfully submitted,



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